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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,231

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Christian Bonetto

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EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

07/15/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/534,231	Applicant(s) BONETTO ET AL.	
	Examiner Paul Marcantoni	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-44 is/are pending in the application.
- 4a) Of the above claim(s) 32-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/3/07;4/17/07;8/9/06;8/3/05;5/6/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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Response to Restriction:

Applicant's election with traverse of Group I, claims 14-31 in the reply filed on 4/18/08 is acknowledged. The traversal is on the ground(s) that the restriction is improper under international practice as stated in their response. The examiner maintains the restriction is proper for the reasons the requirement. The examiner notes that Groups I and II will be *rejoined* as indicated in this restriction requirement upon a finding of allowable claims to the Group I product. The requirement is still deemed proper and is therefore made FINAL.

102/103:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-31 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Langford '456 A1, '388 A1, or '653 A1, Patel '786 (From PCT Int'l Search Report-Y reference), FR 2818635 (From Int'l Search Report-Y reference), or EP 0496682 (From PCT Int'l Search Report-Y reference).

Langford teaches joint compound compositions comprising Ca sulfate hemihydrate, organic binder, and wax as water repellent thus anticipating applicants' claims (see claims). Note that all Langford references teach the same scope of invention. Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art. Further, the use of an organic binder in powder form is an obvious design choice for one of ordinary skill in the art. The applicants state in [0089] of their specification that the organic binder is preferably used in the form of a redispersible powder. Thus, it is clear that other forms (e.g. liquid, granule, etc.) can also be used to achieve the same result upon mixing with the other joint compound compositions.

Patel '786 teaches all the same components and thus overlaps applicants' instant claims and anticipates them (see claims). Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art.

FR 2818635 and EP 496682 both teach compositions comprising the same components in the applicants' claimed range of amounts thus anticipating applicants'

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claims. Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art.

35 USC 103:

Claims 14-31 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Langford '456 A1, '388 A1, or '653 A1, Patel '786 (From PCT Int'l Search Report-Y reference), FR 2818635 (From Int'l Search Report-Y reference), or EP 0496682 (From PCT Int'l Search Report-Y reference) alone or in view of Sellers et al. '805, Shoshany '615 B2, Seto (JP 55027807 abstract), or Akasaka et al. (JP 49001622 abstract).

The primary references teach the applicants' composition as stated above. However, the addition of waterproofing additives such as wax, silicone/siloxanes, or fatty acids is old and conventional in the art for gypsum and cements. Sellers et al. teach adding siloxane to waterproof gypsum compositions is known in the art. Shoshany teaches it is known in the art to add wax to gypsum compositions to impart water resistance. Seto et al. teach it is known in the art to add fatty acids salts as water repellents to gypsum compositions (see abstract). Akasaka et al. teach it is old in the art to add stearic acid to waterproof gypsum board. Thus, the addition of these additives to waterproof or as water repellent for gypsum is old and conventional in the art and their addition to the primary references containing gypsum for the purposes of water repellency would have been an obvious design choice for one of ordinary skill in the art.

Claims 17, 20, and 28 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The term "type" is indefinite. Substitution of --form--- for type should resolve this issue.

The applicants are respectfully requested to remove the "-" between alkaline earth in claims 20 and 28.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Marcantoni/
Primary Examiner, Art Unit 1793